

REMARKS/ARGUMENTS

Reexamination and reconsideration of this Application, withdrawal of the rejections, and formal notification of the allowability of all claims as now presented are earnestly solicited in light of the above amendments and remarks that follow. Claims 3, 4, 8, 9, 12-14, 20, 21, 24-27, and 33-45 are pending in the application. Claim 27 is amended herein to recite that the first section of filter material is free of adsorbent material. Still further, independent claim 27 has been amended to recite that the breakable capsule is downstream from the adsorbent material present in the filter element and is also free of adsorbent material. These amendments are clearly supported by the specification, such as in Fig. 10 and the accompanying discussion. Figure 10 does not show any adsorbent materials within either the capsule or the mouth end section of filter material containing the capsule. In addition, on page 21, the application recites that the breakable capsule is positioned downstream of the adsorbent material within the filter and notes that the intention of the filter design is to create minimal interaction between the contents of the breakable capsule and the adsorbent material. Applicants respectfully submit that no new matter is introduced by these amendments.

The Examiner indicates that the European Search Report intended to be conveyed with the last Information Disclosure Statement did not reach the Examiner. The European Search Report is listed in PAIR as an NPL document filed March 26, 2008. If the Examiner is unable to retrieve this document, Applicants will be glad to provide another copy for consideration.

All claims of record have been rejected as obvious over a combination of U.S. Patent No. 3,251,365 to Keith II *et al.* in view of U.S. Patent No. 3,390,686 to Irby Jr. *et al.* With respect to claim 9, the above-noted references are further combined with U.S. Patent No. 3,459,194 to Eichel. With respect to claim 12, the above-noted references are combined with U.S. Patent No. 5,714,126 to Frund. With respect to claims 41-44, the above-noted references are combined with U.S. Patent No. 5,979,459 to Schneider.

In the last Office Action, the Examiner commented that certain features relied upon by the Applicants as a distinction over the cited art were allegedly not represented in the claims. In

particular, the Examiner noted that the concept of avoiding mixing the liquid from the capsule with the adsorbent material is not sufficiently recited in the rejected claims.

In order to expedite prosecution of the application, Applicants have attempted to clarify preferred aspects of the invention in independent claim 27, including the relationship within the filter element between the position of the breakable capsule and the position of any adsorbent material contained within the filter element. As clearly described in the drawings of the invention and taught in the specification, the intention is to provide a filter element with the capsule positioned downstream from any adsorbent material. Accordingly, the filter design does not include any adsorbent material within the first section of filter material or within the capsule itself, which instead preferably includes a flavoring agent. Consequently, claim 27 has been amended to recite these further aspects of the invention.

It is believed that the claims, as amended, are even further distinguishable from the cited art. While Applicants do not acquiesce to the rejections of record of the claims in their original scope, in order to expedite prosecution, Applicants have amended the claims in a manner that is believed to provide even greater distinctions between the teachings of the cited art and the claimed invention. Even if one of ordinary skill in the art were motivated to combine the Irby and Keith references as relied upon by the Examiner, the resulting combination would necessarily include either a capsule containing a slurry of adsorbent within a liquid material or a section of filter material containing both carbon particles and microcapsules containing a moisturizing liquid. These are the only two embodiments taught in Irby. Such a filter design would not result in a filter element wherein the mouth end section of filter material contains a breakable capsule but is free of adsorbent material and/or would not result in a filter element wherein the breakable capsule is free of adsorbent and positioned downstream from any adsorbent material present in the filter element. Accordingly, Applicants respectfully request reconsideration and withdrawal of all rejections relying on the combination of the Irby and Keith references.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of

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this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

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